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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,293	11/14/2003	Shane Behbahany	50481/5	1152
3528	7590	06/07/2005	EXAMINER	
STOEL RIVES LLP - PDX 900 SW FIFTH AVENUE SUITE 2600 PORTLAND, OR 97204			ALIE, GHASSEM	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,293

Applicant(s)

BEHBAHANY, SHANE

Examiner

Ghassem Alie

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04/16/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I. Figs. 1 and 2; and

Species II. Fig. 3.

2. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

3. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

4. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

5. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the

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evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor or at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. During a telephone conversation with Mr. Ferris Kassim (Reg. No. 39,974) on 06/01/05 a provisional election was made with traverse to prosecute the invention of Group II, claims 1-6. Affirmation of this election must be made by applicant in replying to this Office action.

Drawings

9. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 112' and 116' in Fig. 3. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is

being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

10. The disclosure is objected to because of the following informalities: "second tensioning member 120'" should be --first tensioning member 120'--. See paragraph 13, line 5 in the specification. Appropriate correction is required.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 3, 4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe (2,532,981). Regarding claims 1, 4, and 5, Wolfe teaches a chain saw 1 including a chain saw bar 20 mounted to chain saw 1 via at least one mounting stud. Wolfe also teaches a sliding member 25 adjacent to a first tensioning member 40, wherein the first tensioning member biases sliding member 25 in a direction such when the apparatus is incorporated into chain saw bar 20 and mounted to chain saw 22 having a mounting stud, sliding member 25 is biased towards the mounting stud. Wolfe also teaches a latch 25' which is configured to be receive in a recess 24', and wherein latch 25' is biased and enters recess 24' and prevent

sliding member 25 from moving towards the mounting stud. Bar 20 inherently is attached to saw chain by mounting studs. In addition, the use of a mounting stud to mount the chain saw bar to a saw bar is well known in the art such as taught by Walker (3,382,898). Slider 25 when is forced toward the mounting studs it will be forced in a direction away from the mounting stud until latch 25' enters the recess 24'. See Fig. 2 in Wolfe. Wolfe does not expressly teach that the sliding member has a recess and the latch is received in the recess of the sliding member. Instead, Wolfe teaches that the slider has a latch which is a spring finger and is received in the recess of flange 24. See Figs. 1-5 in Wolfe. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to equip the slider with a recess and the flange with a latch in Wolfe, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. Wolfe also teaches that the latch 25' is a finger spring which inherently has an integrated biasing means. The spring and the latch are not separated in Wolfe. Wolfe does not expressly teach that the latch is adjacent to the second tensioning member and the tensioning member and the latch are separated. It should be note that applicant admitted that the latch can be separated from the second tensioning member or can be integral with the second tensioning member. See paragraph 11 in the specification of the instant application. In addition, spring finger 25' inherently is made of a latch and a tensioning member. The latch is defined by the tip portion of the spring 25' which enters recess 24' and the lower portion of the spring finger defines the second tensioning member.

Regarding claim 3, Wolfe teaches everything noted above including that the first tensioning member and the second tensioning member comprises springs.

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13. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe in view of Jue et al. (6,442,843), hereinafter Jue. Regarding claims 1, 4, and 5, Wolfe teaches a chain saw 1 including a chain saw bar 20 mounted to chain saw 1 via at least one mounting stud. Wolfe also teaches a sliding member 25 adjacent to a first tensioning member 40, wherein the first tensioning member biases sliding member 25 in a direction such when the apparatus is incorporated into chain saw bar 20 and mounted to chain saw 22 having a mounting stud, sliding member 25 is biased towards the mounting stud. Wolfe also teaches a latch 25' which is configured to be receive in a recess 24', and wherein latch 25' is biased and enters recess 24' and prevent sliding member 25 from moving towards the mounting stud. Bar 20 inherently is attached to saw chain by mounting studs. In addition, the use of a mounting stud to mount the chain saw bar to a saw bar is well known in the art such as taught by Walker (3,382,898). Slider 25 when is forced toward the mounting studs it will be forced in a direction away from the mounting stud until latch 25' enters the recess 24'. See Fig. 2 in Wolfe. Wolfe does not expressly teach that the sliding member has a recess and the latch is received in the recess of the sliding member. Instead, Wolfe teaches that the slider has a latch which is a spring finger and is received in the recess of flange 24. See Figs. 1-5 in Wolfe. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to equip the slider with a recess and the flange with a latch in Wolfe, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. In addition, the use of a tensioning member adjacent to latch instead a latch integral with a tensioning member is well known in the art such as taught by Jue. Jue teaches a sliding member 25 having a plurality of recesses

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32, 34 which receives a latch 54. The sliding member is adjacent a first tensioning member 38, wherein the first tensioning member biases the sliding member in a forward direction. Latch 54 is adjacent to a second biasing member 56 and the second tensioning member biases the latch towards the sliding member. Jue also teaches that the recesses 32, 34 of sliding member 25 are configured to receive latch 54. See Fig. 5-10 and col. 3, lines 10-67 and col. 4, lines 1-65 in Jue. It would have been obvious to a person of ordinary skill in the art to provide Wolfe's locking mechanism with the sliding member having a recess and the latch adjacent to a second tensioning member, as taught by Jue, since the locking mechanisms in Jue and Wolfe function the same and they produce the same result.

Regarding claims 2 and 6, Wolfe teaches everything noted above except that the sliding member 25 has a plurality of recesses 32, 34 formed therein that enable the sliding member to be ratcheted away from the mounting stud in a step-like fashion. However, Jue teaches everything noted above including that sliding member 25 has a plurality of recesses 32, 34 formed therein that enable the sliding member to be ratcheted away from the mounting stud in a step-like fashion. See Fig. 10 in Jue and Fig. 2 in Wolfe. It would have been obvious to a person of ordinary skill in the art to provide Wolfe's locking mechanism with the sliding member having a plurality of recesses, as taught by Jue, in order to adjust the extension of the sliding member and the length of the cutting surface extending from the chain saw.

Regarding claim 3, Wolfe teaches everything noted above including that the first tensioning member and the second tensioning member comprises springs.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Calkins et al. (6,049,986), Strunk (2,765,821), Walker (3,194,284), Talberg (5,174,029), Haughey (6,694,623), (3,382,898), and Lindehall (6,311,599) teach a chain saw bar tensioning apparatus.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (571) 272-4501. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, SEE <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (too-free).

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GA/ga

June 1, 2005

A handwritten signature in black ink, appearing to read "Aly" or "Aly", with a long, sweeping diagonal stroke extending upwards and to the right.

Allan N. Shoap
Supervisory Patent Examiner
Group 3700